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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,479	01/21/2004	Naheed Visram	12361-18US JEL	9803

7590 10/05/2006  
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CANADA

EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/760,479

Applicant(s)

VISRAM ET AL.

Examiner

Peter J. Vrettakos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-35 is/are pending in the application.  
4a) Of the above claim(s) 1-15 and 29-35 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 16-23 and 25-28 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9-14-06; 4-27-04.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The action is **final**.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 23 and 25-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 23 (25-27) recites the limitation "said electrical parameter" in line 3. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 16,17,19,20,21,22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. (6,032,674) in view of Shah et al. (6,565,562).**

Eggers et al. (6,032,674) discloses a method of creating channels/holes/cell lysis (col. 3:34-36) in cardiac septal material ("heart tissue" - includes septal material – col. 1:59-60, also inherently includes the fossa ovalis) in which channels (implies

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“second desired locations”) are created by delivering RF (col. 12:55) energy/current into material (see figure 11) from active electrode (first sentence of the Abstract) with distal region (200, figure 11) softer than a proximal region (344, figure 11) introduced through the vasculature (see figure 11) using a dilator (340, figure 11) and guiding sheath (col. 5:50-55; again see figure 11) aided with fluoroscopy/radiopaque markers/depth marker (col. 4:59-64).

*Eggers et al. is silent regarding a grounding pad as the return electrode as well as creating a channel through “septal material”. (Eggers does disclose that the return electrode need not be integral with the disclosed probe and therefore can be attached to a separate device (such as a grounding pad.) See col. 4:31-32, col. 5:55-57 and col. 10:28-30.*

Shah discloses a channeling method analogous to Eggers in which a grounding pad (9) is used as a return electrode. Shah also discusses RF creation of a hole in the septal material (“atrial septum”, col. 1:18-21 and col. 2:19-22).

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Eggers in view of Shah by including into the Eggers method a grounding pad as disclosed by Shah the motivation being to permit monopolar energy application by using a well-known and tested structure (grounding pad element 9) as seen in Shah figure 1. It would further be obvious to use the Eggers method for creating a hole in septal material the motivation being to “improve intertribal communication” posited in Shah col. 2:22.

**2. Claims 18, 23 and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggers et al. (6,032,674) in view of Shah et al. (6,565,562) and further in view of Krishnan (2004/0133113).**

*Eggers/Shah is silent regarding electrocardiograms.*

Krishnan (prior presented and well described in the action dated 2-14-06) discloses in an analogous procedure, using an electrocardiogram.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Eggers in view of Shah and further in view of Krishnan by including into the Eggers method electrical parameter sensing as disclosed by Krishnan the motivation being to permit measurement of electrical parameters in order to determine location of the distal tip of the catheter.

### ***Response to Arguments***

Applicant's arguments with respect to all pending claims have been considered but are moot in view of the new ground(s) of rejection.

The prior 35 USC § 112 rejections are obviated through amendments/clarifying arguments.

Shah, in a method analogous and seamlessly combined with Eggers, clearly discloses creating a channel in septal material. This effectively counters the argument that Eggers does not disclose creating channels in *septal material*.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-23 and 25-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-28, 30, 51, 53 and 55 of copending Application No. 10/666,288. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims involve RF creation of holes in the cardiac septum.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

A terminal disclaimer should be filed in application 10/666,288, as well.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
September 22, 2006



ROY D. GIBSON  
PRIMARY EXAMINER